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EXAMINER

MOORE, M

ART UNIT PAPER NUMBER

1712

DATE MAILED: 09/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/331,959

Applicant(s)

Dubouis et al.

Examiner

Margaret Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 31, 2001.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 - 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takita et al.

Applicants have amended claim 1 such that component D requires a hydrosilyl group containing component. The obviousness of such a component has previously been addressed. For instance see paragraph 7 of the office action dated March 31, 2000, as it applied then to claims 4 to 7 and 10. Applicants' response states that Takita et al. fail to disclose the polyorganosiloxane composition D, but it acknowledges the teachings in Takita et al. that a hydrosilyl group containing component can be used as a crosslinking agent with an alkenylsilyl group component. Thus one having ordinary skill in the art would have found a silicone rubber composition containing the claimed components in (D) to have been obvious over the teachings of Takita et al., particularly noting column 5, lines 3 to 10.

The Examiner notes that applicants' traversal of the obviousness of claims 4 to 7 and 10, which previously required the component now required in claim 1, merely relies on reasons noted in overcoming the rejection of claim 1. Such reasons fail to overcome the obviousness of the instant claims. For the record, note that newly added independent claims 16, 18 and 20 appear to reflect the limitations of dependent claims 4 to 7, already addressed. Applicants haven't provided any specific grounds addressing the non-obviousness of these claims and thus this rejection applies to claims 16 to 21, as well.

3. Claims 1 to 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over '644 in view of Matsushita.

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This rejection relies on the rationale detailed in paragraph 6 of the previous office action. As noted, Matsushita indicate the alternative and equivalent use of silicone rubbers which cure via an SiH/platinum catalyst cure mechanism and a peroxide cure mechanism. One having ordinary skill in the art would have been motivated by the teachings of Matsushita to use silicone rubber forming components such as those found in instant claims 4 to 7 in the silicone rubber forming composition of '644 with a reasonable expectation of success.

Applicants' traversal of this rejection fails to overcome this obviousness. Applicants rely on the differences between the iron oxide additive in '644 and Matsushita et al. in this traversal. This difference, however, fails to cast a shadow on the obviousness of using one silicone rubber component for another, the basis of this obviousness rejection. Applicants further state that "neither JP '644 nor Matsushita disclose or suggest the polyorganosiloxane composition D as defined in claim 1 comprising an alkenylsilyl group carrying constituent and a hydrosilyl group carrying constituent crosslinkable at room temperature..." but this position is not understood, as Matsushita teaches such a composition on the bottom of column 4 through the top of column 5.

4. Claims 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 14, it is unclear what is required by this claim. Note that "one or more" indicates that only one or more of the following compounds are required. However the word "and" indicates however indicates that all of the compounds are required.

In claim 15, reference to "hydroalkenyl" group carrying constituents lacks antecedent basis.


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5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication should be directed to Margaret G. Moore at telephone number (703) 308-4334.

Any **official** documents (after final rejection) can be faxed to (703) **872-9310**. All other **official** faxes should be sent to (703) **872-9311**. Please do not send any informal communication or proposed amendments to this number.


Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
9/24/2001